



PATENT

Customer Number 22,852

Attorney Docket No. 7414.0059-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Russell HIGUCHI

Serial No.: 08/968,208

Filed: November 12, 1997
(CPA Filed: November 20, 2000)

For: INSTRUMENT FOR MONITORING
NUCLEIC ACID AMPLIFICATION

Box Issue Fee

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

) **Notice of Allowance Dated:**
) **03/07/2003**

) **Confirmation No.: 8271**

) **Group Art Unit: 1743**

) **Examiner: Snay, J.**

) **ATTN: BOX ISSUE FEE**

SUBMISSION OF FORMAL DRAWINGS

Subject to the approval of the Examiner, please replace the originally-filed drawings with the nine (9) sheets of formal drawings filed herewith (Figures 1 through 8). Text above the drawings in Figures 1 to 3 that was included in the initially-filed Figures 1 to 3 is deleted in the enclosed formal drawing figures. In parent application Serial No. 07/695,201, which is now U.S. Patent No. 5,994,056, that text in Figures 1 to 3 was also deleted when the formal drawings were submitted. If the formal drawings for any reason are not in full compliance with the pertinent statutes and regulations, please so advise the undersigned.

If any fees are necessary for the submission of these formal drawings, please charge our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

M. Paul Barker
Reg. No. 32,013

Dated: March 14, 2003

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TRANSMITTAL LETTER

We enclose an Issue Fee Transmittal, Submission of Formal Drawings (one set of nine pages), Fee Address for Maintenance Fee Purposes, Request for Special Handling, Letter Concerning Correction of Title and Concerning Comments by Examiner about Information Disclosure Statement, and a check for \$1,300.00 for the Issue Fee.

Please grant any extensions of time required to enter these papers and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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#48

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) Examiner: Snay, J.

) ATTN: BOX ISSUE FEE

Box Issue Fee

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR SPECIAL HANDLING

Applicant requests special handling for expedited issuance of this application.

M.P.E.P. 1309 states that special handling will be given to allowed cases that have a U.S. effective filing date more than five (5) years old. See M.P.E.P. 1309, Eighth Edition, at page 1300-23, second column. This application has an effective filing date of May 2, 1991, which is greater than eleven years old.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 14, 2003

By:

M. Paul Barker
Reg. No. 32,013

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Match and Return



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In re Application of:) Notice of Allowance Dated:
) 03/07/2003
Russell HIGUCHI)
) Confirmation No.: 8271
Serial No.: 08/968,208)
) Group Art Unit: 1743
Filed: November 12, 1997)
(CPA Filed: November 20, 2000)) Examiner: Snay, J.
)
For: INSTRUMENT FOR MONITORING) ATTN: BOX ISSUE FEE
NUCLEIC ACID AMPLIFICATION)

Box Issue Fee

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

**LETTER CONCERNING CORRECTION OF TITLE OF APPLICATION
AND CONCERNING COMMENTS BY EXAMINER ABOUT
INFORMATION DISCLOSURE STATEMENT**

Title

Applicant requests that the U.S. Patent and Trademark Office correct the title of the application in the Notice of Allowance to read:

INSTRUMENT FOR MONITORING NUCLEIC ACID AMPLIFICATION

The correct title is included in the Amendment filed February 26, 2002. A marked up version showing the correct title is included on the Issue Fee Transmittal filed herewith.

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Information Disclosure Statement

Along with the Notice of Allowability the Examiner made certain comments about the Information Disclosure Statement (IDS) filed February 21, 2003, which applicant addresses now.

First, the Examiner contended that he did not consider WO 93/16194, because the submitted Search Report allegedly did not originate from a counterpart application as defined in MPEP 609. The Examiner failed to explain why he considered that European Patent Application No. 02015199 was not a counterpart application as defined in MPEP 609. Moreover, the European Search Report published with European Patent Application No. EP 98110423, which also cites WO 93/16194, was submitted with the IDS. In any event, the Examiner did consider U.S. Patent No. 5,871,908, which is a U.S. national phase counterpart of WO 93/161194.

Second, the Examiner stated that he considered the documents from the interference proceedings and the European search reports, but lined through them on the Form 1449 because MPEP 609 allegedly only permits printing patents, publications, and applications on the face of the patent. Applicant asserts that MPEP 609 does not preclude printing of the cited interference documents and European search reports on the face of the patent, since it addresses documents and citations without limitation. Because the Examiner indicated that the documents were considered, however, applicant will not press this issue further.

Third, The Examiner stated that he considered U.S. Application Serial No. 08/266,061 (the '061 application), but lined through its citation on the Form 1449 because it did not include the inventor. The citation on Form 1449 did include the serial

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number and the filing date. The relationship between the '061 application and the present application was discussed in the text of the submitted IDS and sections of the prosecution history were discussed as well.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 14, 2003

By: 
M. Paul Barker
Reg. No. 32,013

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PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Box ISSUE FEE
Commissioner for Patents
Washington, D.C. 20231
Fax (703)746-4000

MAR 17 2003

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence regarding the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or indicated otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notification.

(CURRENT CORRESPONDENCE ADDRESS) (Please Legibly Marking with any correction of this block 1)

22896 7990 03/07/2003

MILA KASAN, PATENT DEPT.
APPLIED BIOSYSTEMS
850 LINCOLN CENTRE DRIVE
FOSTER CITY, CA 94404

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Box Issue Fee address above, or being facsimile transmitted to the USPTO, on the date indicated below.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/968,208	11/12/1997	RUSSELL HIGUCHI	9397	8271

TITLE OF INVENTION: INSTRUMENTS FOR MONITORING NUCLEIC ACID AMPLIFICATION

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1300	\$0	\$1300	06/09/2003

EXAMINER	ART UNIT	CLASS-SUBCLASS
SNAY, JEFFREY R	1743	422-082080

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☒ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

- Vincent M. Powers;
- Finnegan, Henderson, Farabow, Garrett & Dunner, LLP.
-

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) ☐ Individual ☐ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

- ☒ Issue Fee
☐ Publication Fee
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):

- ☒ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☒ The Commissioner is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number 06-0216 (enclose an extra copy of this form).

Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature)

(Date) 03/14/03

M. Paul Barker Reg. No. 32,013

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant, a registered attorney or agent, or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, D.C. 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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